

**Terminal Disclaimer To Obviate A Double
Patenting Rejection Over A Prior Patent**

Docket No.
5801-D1-01-KD

In Re Application Of: Leslie Magnus, et al.

Serial No.
09/921,682

Filing Date
8/3/01

Examiner
P. Spivack

Group Art Unit
1614

Invention: METHOD FOR THE TREATMENT OF INSOMNIA

Owner of Record: Warner-Lambert Company

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

The above-identified owner of record of a 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,306,910. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors and/or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of the full statutory term as presently shortened by any terminal disclaimer.

06/05/2001 10:00:00 A. 200455 0921682

01 FC:188

110.00 CH

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

Karen DeBenedictis
Signature

Dated: May 20, 2002

Karen DeBenedictis
Typed or Printed Name

- ☒ Terminal disclaimer fee under 37 C.F.R. 1.20(d) included.
☐ PTO suggested wording for terminal disclaimer was unchanged.
☐ Certification under 37 C.F.R. 3.73(b) is required if terminal disclaimer is signed by the assignee.

FROM WARNER-LAMBERT CO.

(TUE) 05. 21' 02 15:33/ST. 15:33/NO. 3560555374 P. 1

1603
FAX RECEIVED

MAY 22 2002

GROUP 1600

PTO/SB/87 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

11 pages

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the
United States Patent and Trademark Office at 703-872-9306

on 05/21/2002

Date

Cindy Malocha
Signature

Cindy Malocha

Typed or printed name of person signing Certificate

OFFICIAL

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

Burden Hour Statement: This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Return Fax No. 734-622-1553

Received from <17346221553> at 5/21/02 3:31:05 PM [Eastern Daylight Time]

5801-D1-01-KD